**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (AMENDED) An apparatus comprising:

a peripheral device connected to a host device, wherein a speed of said peripheral device is adjusted in response to [a] one or more predetermined conditions.

3. (AMENDED) The apparatus according to claim [1] 2, wherein said electrical disconnection/reconnection comprises re-enumeration of said peripheral device.

## R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

## CLAIM OBJECTIONS

The objection to claim 20 has been obviated by appropriate amendment and should be withdrawn. Claim 20 has been cancelled.

## CLAIM REJECTIONS UNDER 35 U.S.C. §112

The rejection of claim 3 under 35 U.S.C. §112, second paragraph, has been obviated by appropriate amendment and should be withdrawn.

## CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-20 under 35 U.S.C. §103 as being unpatentable over Dischler '287 is respectfully traversed and should be withdrawn.

Dischler teaches a variable frequency clock control for microprocessor-based computer systems (Title).

In contrast, the present invention provides an apparatus comprising a peripheral device and a host device. The peripheral device may be connected to the host device. The speed of the peripheral device may be adjusted in response to one or more

predetermined conditions. Dischler does not teach or suggest all the elements of the presently claimed invention (see page 3, paragraph 7 of the Office Action). Specifically, Dischler fails to teach or suggest a peripheral device, as presently claimed.

The assertion in the Office Action (page 3, paragraph 7) that "it would have been obvious ... to modify teachings of Dischler to utilize the device speed adjustment technique into a peripheral device since such utilization would have enabled a peripheral device to run at optimal speeds" is not sufficient to establish a *prima facie* case of obviousness.[1] Dischler is silent regarding a peripheral device. The Office Action fails to provide the suggestion or motivation that would lead one skilled in the art to substitute a peripheral device for the computer system of Dischler.

The position taken in the Office Action that a peripheral device may be substituted for the computer system without providing a specific motivation or suggestion in the reference to support such substitution is not proper (see *In re Fine*). The Office

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[1] M.P.E.P. §2143.01 (The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination), citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.).

Action merely states a result, rather than providing a specific motivation or suggestion to support the combination. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness (see *In re Fine*). As such, the presently claimed invention is fully patentable over Dischler and the rejection should be withdrawn.

Furthermore, the use of the general skill in the art to supply missing knowledge or prior art to support an obviousness rejection is not proper. As stated by the Federal Circuit:

> To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.[2]

The conclusory statement that "It would have been obvious for one of ordinary skill in the art at the time of the invention to modify teachings of Dischler et al. to utilize the device speed adjustment technique into a peripheral device since such utilization would have enabled a peripheral device to run at optimal speeds" does not adequately address the issue of motivation to combine.[3] The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. It is improper in determining whether a person

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[2] W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir 1983).

[3] In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

of ordinary skill would have been led to the combination of references simply to use that which the inventor taught against its teacher. The Office Action fails to make the requisite findings based on evidence of record and fails to explain the reasoning by which the findings are deemed to support the conclusion. Therefore, the Office Action fails to meet the Office's burden of factually establishing a *prima facie* case of obviousness (MPEP §2142). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

As such, the presently claimed invention is fully patentable over the cited references and the rejection should be allowable.

Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

Christopher P. Maiorana
Registration No. 42,829
24025 Greater Mack, Suite 200
St. Clair Shores, MI 48080
(586) 498-0670

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